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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,223	03/28/2001	Terry L. McMahon	6714.01	2165
25763 7590 04/02/2008 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT SUITE 1500 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498				
			EXAMINER NELSON, FRED A ANN	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 04/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/820,223

Applicant(s)

MCMAHON ET AL.

Examiner

FREDA A. NELSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-25 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

The amendment received on February 7, 2008 is acknowledged and entered.

Claims 1-22 and 26 have been canceled. No claims have been added. Claims 23-25 and 27-31 are currently pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 7, 2008 has been entered.

Response to Amendments and Arguments

Applicant's arguments filed February 7, 2008 been fully considered but they are not persuasive.

In response to applicant's arguments that Henson does not suggest or teach a method of building a custom specification and a quote for purchasing or leasing a piece of equipment by a potential customer from a salesperson, the examiner respectfully disagrees. Henson discloses in the later instance, the previous online store allowed such customers to answer one of their questions, but not all of them. Those customers still needed the assistance of a sales representative (col. 1, lines 29-47). Henson

further discloses merchandising is provided to better emulate what a sales representative would do if a customer telephones the online store vendor to inquire about a computer system, wherein the online store merchandising provides a potential to sell a customer a richer computer system. The merchandising of the online store better emulates selling and cross-selling merchandising than a sales representative could perform (col. 15, lines 46-53; see FIG. 7 [Sales rep]).

Examiner's Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson (Patent Number 6,167,383).

As per claim 23, Henson discloses a method in a computerized system for building a custom specification and a quote for a piece of equipment, by a potential customer from a sales person, comprising:

making a request in the computerized system to build the custom specification and the quote to purchase a piece of equipment based on the built custom specification (col. 6, lines 18-21); ;

providing at least one pre-engineered specification, wherein the pre-engineered specification is a specification for one or more designs of a component for which existing designs have been completed (col. 1, lines 23-25);

displaying the at least one pre-engineered specification for the equipment (col. 1, lines 23-25);

electronically soliciting from a user a selection of one of the at least one pre-engineered specification (col. 7, line 57 through col. 8, line 6);

electronically soliciting from the user a manufacturer of one component of the equipment (FIG. 3A);

displaying options and prices for the component and allowing the user to select at least one option for the component, wherein the displaying options and prices includes updating the displayed options and prices after an interrelated option has been selected (FIG. 3A-3B and FIGS. 4-6);

generating a report showing the options selected for the component and a subtotal cost for the component (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6); and
generating a report showing the components selected and the total cost of the equipment (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6).

As per claim 24, Henson discloses a method in a computerized system for building a custom specification and a quote for leasing a piece of equipment by a potential customer from a salesperson, comprising:

making a request in the computerized system to build the custom specification and the quote to purchase a piece of equipment based on the built custom specification;

providing at least one pre-engineered specification to at least one of the potential customer and the salesperson wherein the pre-engineered specification is a specification for one or more designs of a component for which existing designs have been completed (col. 1, lines 23-25, FIGS. 3A and 4);

displaying the at least one pre-engineered specification for the equipment (col. 1, lines 23-25);

electronically soliciting from the at least one of the potential customer and the salesperson a user a selection of one of the at least one pre-engineered specification (col. 7, line 57 through col. 8, line 6);

electronically soliciting from the at least one of the potential customer and the salesperson a manufacturer of one component of the equipment (FIG. 3A);

displaying options and prices for the component and allowing the at least one of the potential customer and the salesperson to select at least one option for the component, wherein the displaying options and prices includes updating the displayed options and prices after an interrelated option has been selected (FIG. 3A-3B and FIGS. 4-6);

generating a report showing the options selected for the component and a subtotal cost for the component (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6); and

generating a report showing the components selected and the total cost of the equipment (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25 and 27-28 are rejected under rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (Patent Number 6,167,383), in view of Hanzek (US Patent Number 6,980,963), still in further view of Thompson (US Patent Number 6,810,401).

As per claims 25 and 27-28, Henson does not expressly disclose wherein the leased equipment is construction equipment, manufacturing equipment, and vehicle fleet. Information as to wherein the leased equipment is manufacturing equipment,

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vehicle fleet or construction equipment is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in claims 25 and 27-28 would be performed the same regardless of the type of equipment.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that it was old and well known to purchase or lease a variety of products because such type of equipment does not functionally relate to the steps in the method claimed and because the type of equipment leased does not patentably distinguish the claimed invention.

As per claims 29-31, Henson does not expressly disclose that the method of claim 23, wherein the equipment is a construction equipment.

However, Hanzek discloses after the on-line consumer selects the vehicle make and model, configurations and options, he/she may submit the vehicle selection and perform a search in inventory to determine if one is currently available. Inventory database 322 receives its data from an inventory importer 328, which obtains inventory

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data from dealers 330 for their current inventory. Dealers 330 may also represent any sales entity that has an inventory of products for sale or lease to the public or to businesses (col. 8, lines 23-31).

Thompson et al. disclose although the configuration system (and corresponding method) has been specifically described in connection with the configuration of a window/door product, it should be apparent that the system (and method) can be applied to any product, service, or component that is to be designed or configured such as cabinets, rooms, houses, cars, landscape designs, clothing, etc (col. 18, lines 24-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Henson et al. to include the feature of Hanzek and Thompson et al. in order to provide the users with the ability to configure and get quotes for vehicles and various other products.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Factor (US Patent Number 6,564,112), which discloses a method of customizing electronic systems based on user specifications.

2) Lemchen (US Patent Number 6,594,642), which discloses an automated customized remote ordering and manufacturing process.

3) Henson (US patent Number 7,035,815), which discloses a method and apparatus for computer system online lead time advisor.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday -Tuesday and Thursday-Friday, 7:30 am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. A. N./
Examiner, Art Unit 3628
03/30/2008

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628